

REMARKS

A substitute specification including claims (prior to amendment) with markings showing the amendments to the specification only is submitted herewith. A clean copy of the substitute specification is also included herewith. Claim 7 has been amended. Claims 1-13 are pending in the case. Further examination and reconsideration of pending claims 1-13 are hereby respectfully requested.

Priority Claim Under 35 U.S.C. 119(e)

The Office Action states: "Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows: An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification." (Office Action -- page 2). The specification has been amended to include in the first sentence a specific reference to the prior application to which the current application claims priority under 35 U.S.C. 119(e). Accordingly, the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) have now been met.

Specification

The Office Action states: "A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the pages do not have proper top margins, resulting in holes being punched in the text during initial application processing." (Office Action -- page 2). As noted above, a substitute specification (both a clean copy and a copy with markings showing amendments) is submitted herewith. The substitute specification contains no new matter. Accordingly, entrance of the substitute specification is respectfully requested.

Objections to the Specification

The Office Action states: "The disclosure is objected to because of the following informalities: on page 4, the status of the copending application should be updated." (Office Action -- page 3). The Specification has been amended to update the status of the copending application listed on page 4 of the Specification. Accordingly, removal of the objections to the Specification is respectfully requested.

Section 102(e) Rejections

Claim 7 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,420,864 to Abraham et al. (hereinafter “Abraham”). As will be set forth in more detail below, this rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP § 2131. The cited art does not disclose all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

The cited art does not teach a semiconductor fabrication tool for processing semiconductor wafers and a pod, interfaced to the tool at a load port, which includes a mechanism for inspecting or measuring the wafers. Amended independent claim 7 recites in part: “a semiconductor fabrication tool, for processing semiconductor wafers; and, a pod, interfaced to said tool at a load port, wherein said pod includes a mechanism for inspecting or measuring said wafers.” Support for the amendments to claim 7 can be found in the Specification as originally filed, for example, on page 9, lines 5-11.

Abraham discloses a modular substrate measurement system. Abraham, however, does not disclose a semiconductor fabrication tool for processing semiconductor wafers and a pod, interfaced to the tool at a load port, which includes a mechanism for inspecting or measuring the wafers. For example, Abraham states that “FIG. 2 shows a second embodiment of the present invention of a substrate measurement system wherein a plurality of stations is distributed in a substantially horizontal plane around a centrally mounted substrate handling chamber 7, provided with wafer transfer means 10.” (Abraham -- col. 3, lines 14-18). Abraham also states that “Two substrate container interfaces 1 and 2 are shown with substrate container 8 and 9 installed on substrate container interface 1 and 2, respectively. Four measurement chambers 30, 31, 32, 33 are shown, each connected to substrate handling chamber 7.” (Abraham -- col. 3, lines 21-25). Therefore, Abraham teaches a substrate container interfaced to a substrate measurement system. However, Abraham does not teach a substrate container interfaced to a semiconductor fabrication tool for processing semiconductor wafers. As such, Abraham does not teach a semiconductor fabrication tool for processing semiconductor wafers and a pod, interfaced to the tool at a

load port, which includes a mechanism for inspecting or measuring the wafers, as recited in claim 7. Therefore, Abraham does not teach all limitations of claim 7.

For at least the aforementioned reasons, claim 7 is not anticipated by the cited art. Accordingly, removal of the § 102 rejection of claim 7 is respectfully requested.

Section 103(a) Rejections

Claims 1, 2, 5, 6, and 8-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abraham in view of U.S. Patent No. 6,625,497 to Fairbairn et al. (hereinafter "Fairbairn"). Claims 3, 4, 12, and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abraham in view of Fairbairn and further in view of U.S. Patent No. 6,591,162 to Martin. (hereinafter "Martin"). As will be set forth in more detail below, the § 103 rejections of claims 1-6 and 8-13 are respectfully traversed.

Fairbairn is not available as prior art against the current application. In particular, the filing date of the U.S. Parent Application to which Fairbairn claims priority cannot be used as the 35 U.S.C. 102(e) date since the parent application does not support the claims of Fairbairn. In particular, Fairbairn is a continuation-in-part of U.S. Patent Application Serial No. 09/714,984 filed on November 20, 2000, which issued as U.S. Patent No. 6,486,492 to Su (hereinafter "Su"). However, as will be clear upon comparison of Su with Fairbairn, Su does not support the claims of Fairbairn. In particular, Fairbairn includes matter not present in Su to support the claims of Fairbairn. The matter that was added to Fairbairn to support the claims of Fairbairn includes the abstract, the text in col. 2, line 48 - col. 3, line 14, col. 3, lines 18-20 and 26-50, col. 4, lines 22-31 and 46-50, col. 6, lines 23-34, col. 7, lines 3-18, col. 10, line 35 - col. 15, line 43, and Figs. 7-10. The remaining portions of Fairbairn, which correspond to the matter included in Su, does not support the claims of Fairbairn. As such, the 35 U.S.C. 102(e) critical date of Fairbairn is the filing date of Fairbairn (July 10, 2001), not the filing date of the parent application.

The filing date of a U.S. Parent Application can only be used as the 35 U.S.C. 102(e) date if it supports the claims of the issued child. In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must (A) have a right of priority to the earlier date under 35 U.S.C. 120 and (b) support the invention claimed as required by 35 U.S.C. 112, first paragraph. "For if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art' " under 35 U.S.C. 102(e). *In re Wertheim*, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981). MPEP 2136.03. In addition, since the

present application has a priority date of August 17, 2000, the priority date of the present application is earlier than the filing date of Fairbairn. As such, Fairbairn is not available as prior art against the current application.

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). The remaining available cited art does not teach or suggest all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

The remaining available cited art does not teach or suggest inspecting a semiconductor wafer in a pod, which is coupled to a semiconductor fabrication tool. Independent claim 8 recites, in part: "inspecting a semiconductor wafer in a pod, wherein said pod is coupled to a semiconductor fabrication tool." Independent claims 1, 9, 10, and 11 recite similar limitations. As set forth in detail above, Abraham does not teach a pod interfaced to a semiconductor fabrication tool for processing semiconductor wafers. In addition, the Office Action acknowledges this deficiency in the teachings of Abraham by stating that "Abraham however does not specifically provide a processing chamber." (Office Action -- page 5). Therefore, Abraham cannot teach or suggest inspecting a semiconductor wafer in a pod, which is coupled to a semiconductor fabrication tool, as recited in claims 1, 8, 9, 10, and 11.

The Examiner has proposed combining Abraham with Fairbairn to overcome this deficiency in the teachings of Abraham. However, as set forth above, Fairbairn is not available as prior art against the present claims. As such, Fairbairn cannot be combined with Abraham to overcome deficiencies therein. In addition, Martin does not teach or suggest inspecting a semiconductor wafer in a pod, which is coupled to a semiconductor fabrication tool. In particular, Martin does not teach or suggest inspecting a semiconductor wafer whatsoever. As such, Martin cannot be combined with Abraham to overcome deficiencies therein.

For at least the reasons set forth above, none of the available cited art, either individually or in any combination thereof, teaches or suggests inspecting a semiconductor wafer in a pod, which is coupled to a semiconductor fabrication tool, as recited in claims 1, 8, 9, 10, and 11. Consequently, the cited art does not teach or suggest all limitations of claims 1, 8, 9, 10, and 11.

For at least the reasons stated above, claims 1, 8, 9, 10, and 11, as well as claims dependent therefrom, are patentably distinct over the cited art. Accordingly, removal of the § 103 rejections of claims 1-6 and 8-13 is respectfully requested.

CONCLUSION

This response constitutes a complete response to all issues raised in the Office Action mailed September 28, 2004. In addition, the art cited but not relied upon is not believed to be pertinent to the patentability of the present claims. In view of the remarks traversing rejections presented therein, Applicants assert that pending claims 1-13 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned earnestly requests a telephone conference.

The Commissioner is authorized to charge any fees which may be required, or credit any overpayment, to deposit account number 50-3268/5589-04400.

Respectfully submitted,



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